REMARKS

In the Office Action dated October 26, 2004, claims 1-28 were presented for examination. The Examiner objected to claims 9, 12, 18, and 21. Claims 1-28 were rejected under 35 U.S.C. §103(a).

Applicants wish to thank the Examiner for the careful and thorough review and action on the merits in this application. The following remarks are provided in support of the pending claims and responsive to the Office Action of October 26, 2004 for the pending application.

I.   Objection to Claims 9, 12, 18, and 21

In the Office Action of October 26, 2004, the Examiner assigned to the application objected to claims 9, 12, 18, and 21 for containing informalities. Applicants have amended claims 9, 12, and 18 to correct the informalities. Support for the amendment to claims 9 and 18 are found on page 8, lines 17-23 of the Specification. The language in claim 21 is correct, and claim 12 has been amended to remove the discrepancy between claims 12 and 21. Accordingly, Applicants respectfully request that the Examiner remove the objection to the claims.

II.   Rejection of claims 1-28 under 35 U.S.C. §103(a)

Claims 1-28 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Elnozahy et al.* (U.S. Patent No. 6,701,421) in view of *Sayles* (U.S. Patent No. 6,549,963).

Applicants hereby incorporate by reference the comments pertaining to *Elnozahy et al.* and *Sayles* as discussed in response to the First Office Action.

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As noted in the Response to the First Office Action, the patent of *Elnozahy et al.* is a method for allocating data having a configuration table, and the patent of *Sayles* is a method for configuring devices on a communication channel using a BIOS routine to change settings in devices coupled to a bus. The fact that *Elnozahy et al.*, *Sayles,* and Applicants' invention pertain to resource descriptors in a computer system is where the similarities between each reference and Applicants' disclosure end. In order to apply *Elnozahy et al.* to Applicants' pending application, *Elnozahy et al.* must be modified and reconfigured in order to support firmware producing a second descriptor, as claimed by Applicants. The Examiner's admission that *Elnozahy et al.* does not teach that the firmware also produces a second descriptor of the respective performance of the resources in effect shows the limitation that is teaching away from Applicants' invention.

Additionally, the Examiner utilizes *Sayles* to teach the limitation of Applicants' second descriptor. However, as admitted by the Examiner, *Sayles* is limited to support of the second descriptor as claimed by Applicants. *Sayles* fails to account for Applicants' claimed first descriptor. Both *Elnozahy et al.* and *Sayles* fail to independently address Applicants' use of both first and second descriptors as a means of achieving improved system performance over that of the prior art. "Although a prior art device 'may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.' " MPEP §2143.01 (citing *In re Mills*, 916 F.2d 680, 682, 16 USPQ 2d. 1430 (Fed. Cir. 1990)). "Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the Applicants' disclosure." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). In fact, both *Elnozahy et al.* and *Sayles* teach away from the modification suggested by the Examiner. *Elnozahy et al.* does not suggest a modification to accommodate a second descriptor. To read *Elnozahy et al.* as providing the second descriptor would require a modification to the invention of *Elnozahy et al.* not envisioned or required.

Furthermore, there is no suggestion found in *Sayles* for a modification to accommodate a first descriptor with the functionality of the first descriptor being that claimed by Applicants. The only suggestion for a system that utilizes both first and second descriptors in the manner
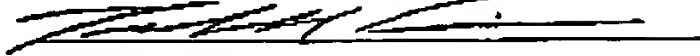
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claimed by Applicants is derived from Applicants' invention. Absent Applicants' invention, there is no suggestion or motivation within the combination of *Elnozahy et al.* and *Sayles* for such a modification. "It is impermissible to use the claimed invention as an instructions manual or 'template' to piece togther the teachings of the prior art so that the claimed invention is rendered obvious." *In re Fritch*, 972 F.2d 1260, 1266, 23 USPQ 2d 1780 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987 (Fed. Cir. 1991)). Yet this is the very process that the Examiner has attempted to undertake. Accordingly, the combination of the prior art references is improper as the Examiner's combination is precipitated by utilizing Applicants' claimed invention as the template to make the modifications suggested by the Examiner – which by its very nature makes such a combination non-obvious.

Finally, when viewed in its entirety, Applicants' invention is greater than the sum of the parts. Utilizing the structure of the first and second descriptors of Applicants provides enhanced operating efficiency. In this manner, it is not whether the individual components of the patent were obvious at the time of the invention, but whether the aggregation produced a new or different result. "A proper nonobviousness analysis judges the claimed invention holistically, not by cobbling together the teachings of different references to match different claim limitations in a piecemeal fashion." Robert E. Schechter et al., *Intellectual Property Law of Copyrights, Patents and Trademarks*, §17.3 at 381 (2003). It is the unique structure of the Applicants' first and second descriptors and how they function together that improves operating efficiency. Unlike either *Elnozahy et al.* or *Sayles*, Applicants' invention uses two descriptors, the first descriptor associated with toplogical levels and the second descriptor associated with performance. The combination of these elements are not present or suggested in *Elnozahy et al.* and *Sayles* for the obvious reasons stated above. However, the elements that *Elnozahy et al.* and *Sayles*, individually or in combination, fail to address are critical to the advantages found in Applicants' invention. Accordingly, the Applicants respectfully submits that claims 1-28 would not have been obvious in view of *Elnozahy et al.* ('421) in view of *Sayles* ('963) and allowance of claims 1-28 is respectfully requested.

For the reasons outlined above, withdrawal of the rejection of record and an

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allowance of this application are respectfully requested.

                                          Respectfully submitted,

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